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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,363	02/07/2002	Richard C. Johnson	ORCL5775/OID-2001-195-01	8641
22430	7590	01/24/2005	EXAMINER	
YOUNG LAW FIRM A PROFESSIONAL CORPORATION 4370 ALPINE ROAD SUITE 106 PORTOLA VALLEY, CA 94028			WORJLOH, JALATEE	
		ART UNIT	PAPER NUMBER	3621

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/071,363	JOHNSON, RICHARD C.
	Examiner	Art Unit
	Jalatee Worjoh	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 December 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 36-65 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/16/03 & 3/17/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1. Claims 36-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 16, 2004.

2. Claims 1-35 have been examined.

Claim Rejections - 35 USC § 101

3. Claims 1 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2dat 1452.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claim 1, 4, 7, 8, 12, 15, 19, 24, 27, 30, 31 are rejected under 35 U.S.C. 102(a) as being anticipated by International Publication No. WO 01/88809 to Anuszewski et al.

Referring to claims 1 and 24, Anuszewski et al. disclose issuing a primary digital certificate to a primary certificate holder (i.e. “buyer”) of a corporation the primary certificate authorizing the primary certificate holder to designate a plurality of holders (i.e. “employees”) of secondary digital certificates that are derivative from the primary certificate, each of the primary and plurality of secondary certificates including at least one of unique identifying information (i.e. public/private keys) and an indication of authority of the holder of the certificate (see page 16, lines 5-10), collecting pending corporate payment requests (i.e. “command to pay”) for clearing against an account of the corporation (see pg. 3, lines 7 & 8), periodically generating a pending payment statement (i.e. “report”) that includes the collected pending payment request (see pg. 17, lines 15-22, 28-31), requiring that each of the collected pending payment requests be validated by an authenticated primary or secondary certificate holder having the authority to validate the payment requests (see pg. 6, lines 25-29), clearing only validated corporate payment requests of the pending payment statement against the corporate account (see pg. 3, lines 9-15; pg. 7, lines 28 & 29).

Referring to claims 4,15, and 27, Anuszewski et al. disclose receiving the primary certificate from the primary certificate holder or one of the secondary certificates from one of the secondary certificate holders, authenticating an identity of the certificate holder from which the certificate received and validating the presented certificate (see pg. 16, lines 5-17).

Referring to claims 7 and 30, Anuszewski et al. disclose receiving a list of validated corporate payment requests (i.e. “privileges”) from an authenticated certificate holder of the corporation and clearing only those corporate payment requests against the corporate account that are listed in the received list of validated corporate payment requests (see pg. 22, lines 3-19).

Referring to claims 8,19 and 31, Anuszewski et al. disclose the requiring step includes a step of validating the collected pending payment requests of the pending payment statement at least partially programmatically (see page 11, lines 23-25).

Referring to claim 12, Anuszewski et al. disclose at least one processor, at least one data storage device, a plurality of processes spawned by said at least on processor (i.e. “payment enabler”), the processes including processing logic for (see pg. 11, lines 11-14) issuing a primary certificate to a primary certificate holder of a corporation, the primary certificate authorizing the primary certificate holder to designate a plurality of holders of secondary digital certificates that are derivative from the primary digital certificate, each of the primary and plurality of secondary certificates including at least one of unique identifying information (i.e. public/private key) and an indication of authority of the holder of the certificate (see pg. 16, liens 5-10), collecting pending corporate payment requests (i.e. command to pay) for clearing against an account of the corporation (see page 3, lines 7 & 8), periodically generating a pending payment statement (i.e. report) that includes the collected pending payment requests (see pg. 17, lines 15-22, 28-31),

requiring that each of the collected payment requests be validated by an authenticated primary or secondary certificate holder having the authority to validate the payment requests (see pg. 6, lines 25-29), clearing only validated corporate payment requests of the pending payment statement against the corporate account (see pg. 3, lines 9-15, pg. 7, lines 28 & 29).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 5, 6, 9-11, 13, 14, 16, 17, 20-23, 25, 26, 28, 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anuszewski et al. as applied to claims 1, 12 and 24 above.

Referring to claims 2 and 25, Anuszewski et al. disclose a primary certificate (see claim 1 above). Anuszewski et al. do not expressly disclose the certificate identifying information uniquely identifying an officer of the corporation and the authority of the officer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The issuing a primary digital certificate step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). At the time the invention was made, it would have been obvious to a person of ordinary skill in

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the art to a primary digital certificate including any type of information because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claims 3, 5, 14, 16, 26 and 28, Anuszewski et al. disclose the primary certificate (see claim 1 above) and storing the authority of the officer by the financial services provider (i.e. “payment enabler server”), see pg. 6, lines 20 & 21. Anuszewski et al. do not expressly disclose the primary certificate includes the identifying information uniquely identifying an officer of the corporation. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The issuing a primary digital certificate step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to a primary digital certificate including any type of information because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claims 6, 18 and 29, Anuszewski et al. disclose a primary certificate (see claim 1 above). Anuszewski et al. do not expressly disclose the indication authority includes at least one of: a maximum payment that the holder of the certificate is authorized to validate, an expiration date of the certificate, payees for which the certificate holder is authorized to validate payments. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The issuing a primary digital certificate step would be performed the same regardless of the data. Thus, this descriptive material will not

distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to a primary digital certificate including any type of information because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claims 9, 20 and 32, Anuszewski et al. disclose requiring step validates each pending payment requests in the pending payment statement (see claim 1 above). Anuszewski et al. do not expressly disclose matching the payment request with a corresponding payment request in an accounting system of the corporation. However, Anuszewski et al. teach a database which stores payment information that is utilized to authorize payment request. It is known in the art that a database is used to collect, retrieve and store information; hence, the examiner notes that the database of Anuszewski et al. can be utilized to match the payment request with corresponding payment request in an accounting system of the corporation. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Anuszewski et al. to include the step of matching the payment request with a corresponding payment request in an accounting system of the corporation. One of ordinary skill in the art would have been motivated to do this because it provides an effective means for quickly validating the payment request.

Referring to claims 10,11, 22, 23, 34 and 35, Anuszewski et al. disclose the pending payment statement generating step generates the pending payment statement at a regular interval (i.e. “predetermined number of calendar days”), see pg. 24, lines 25-28. As for the regular

interval is one of daily and weekly, the examiner notes that predetermined number of calendar days may include only of daily and weekly. At the time the invention was made, it would have been obvious to a person of ordinary skill modify the method disclose by Anuszewski et al. to include a regular interval of daily or weekly. One of ordinary skill in the art would have been motivated to do this because it constantly provides the statements.

Referring to claims 21 and 33, Anuszewski et al. disclose the system wherein access to the accounting system of the corporation is by presentment of the primary certificate or one of the secondary certificates (see pg. 20, lines 25-27).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Publication No. 2004/0111379 to Hicks et al. disclose a primary digital certificate holder and second digital certificate holder that is derivate from the primary certificate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for Regular/After Final Actions and 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

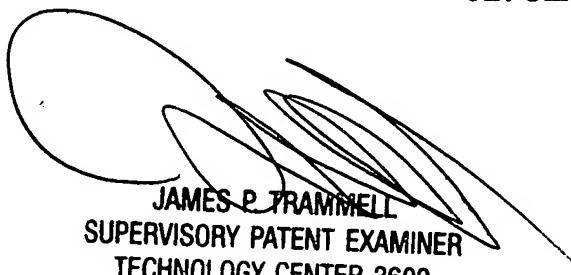
Any response to this action should be mailed to:

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.


Jalatede Worjloh
Patent Examiner
Art Unit 3621

January 18, 2005


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